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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,071	02/20/2002	Roland Neubert	20959/1680 (P 54746)	6986
7590	03/07/2005		EXAMINER	
Joseph M. Noto NIXON PEABODY LLP Clinton Square P.O. Box 31051 Rochester, NY 14603-1051			NILAND, PATRICK DENNIS	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 03/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

1c

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/079,071	NEUBERT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Patrick D. Niland	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 24 January 2005.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-9 and 12-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 and 12-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

1. The amendments of 1/24/05 have been entered. Claims 1-9 and 12-34 are pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/24/05 has been entered.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9 and 12-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5356951 Yearn et al. in view of WO 00/61073 Blackwell et al., DE 3502594 A1 Michl et al., US Pat. No. 4503169 Randklev, and US Pat. No. 4668712 Hino et al..

Yearn et al. discloses particulate composite filler of mean particle size of 5-50 micrometers (column 4, lines 21-24) and tooth filling material containing monomer and the composite filler. Yearn et al. does not disclose the instantly claimed restriction on amount of particles with a size less than 10 micrometers. See column 2, lines 25-41; column 3, lines 40-68; column 4, lines 1-2 and 11-68; column 5, lines 6-9; and the remainder of the document. The examples use the instantly claimed amount of polymerization initiator, which amounts are those commonly employed in polymerization of unsaturated monomers.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed particle size limitations of claims 1 and 2 because

Blackwell et al. discloses the benefits of using such size ratios (page 3, line 21 to page 4, line 26) and these benefits resulting from the particle size limitations of Blackwell would have been expected in the compositions of Yearn. The benefits of the larger particle size distribution of Blackwell are generic to fillers and would have also been expected of the composite fillers of the patentee.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the ytterbium fluoride of the instant claim 8 and 18 because Yearn desires the use of roentgenographic compounds in their compositions and Michl et al. shows ytterbium fluoride to be a particularly useful roentgenographic compound for use in fillings and its properties would have been expected in the composition of Yearn. Use of such fillers is contrary to transparency argued by the applicant.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed precipitated mixed oxides of the instant claims 9 and 22-25 because Yearn teaches that any glass powders can be used at column 3, lines 44-68 and column 4, lines 11-12 and 21-32 and such precipitated mixed oxides would have been expected to give their known properties, as taught by Randklev, to the composition of Yearn, who teaches that known additives may be used.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the layered silicates, i.e. bentonite clays, of the instant claims in the composition of Yearn because they would have been expected to give their known properties, as taught by Hino et al., to the composition of Yearn, who teaches that known additives may be used.

The applicant's arguments are not persuasive for the reasons stated above and because there continues to be no showing of any alleged unexpected results in a manner commensurate in scope with the instant claims and the cited prior art. The applicant's argument with regard to transparency is not persuasive because the instant claims encompass the use of non-transparent fillers. It is not seen that the compositions above are not "polishable" as all such compositions are expected to be "polishable". The cited prior art predicts lowered shrinkage from using the above discussed filler size distribution as well as other enhancements of the physical properties of the cured compositions. The instant claims recite "comprising" and therefore encompass any additional ingredients of the cited prior art. Blackwell is cited for its teaching of the properties which result from the disclosed particle size distribution and these properties are attributed to the particle size distribution without regard to the identity of the filler. They are therefore expected of the composite fillers of Yearn. Shrinkage control and smoothness, which would appear to be related to polishability, i.e. it would require less polishing, e.g. less abrasion, to give the desired final outcome, are obtained by Yearn (abstract).

5. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

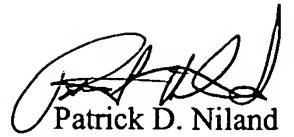
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Primary Examiner  
Art Unit 1714